

REMARKS

Claims 1 through 21 are pending in this application.

I. RESTRICTION REQUIREMENT

In response to the Requirement for Restriction, requiring the Applicant to elect between the inventions of Group I (Claims 1-11 and 19-21) and Group II (Claims 12-18), the applicant provisionally elects group I drawn to claims 1-11 and claims 19-21 with traverse.

As specifically stated in MPEP § 803, the examiner must show that the (A) The inventions must be independent (see MEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP §806.05 - §806.05(i)); **and** (B) There must be a **serious burden** on the examiner if restriction is required (see MPEP §803.02, § 806.04(a) -§806.04(i),§808.01(a), and § 808.02).

The examiner must prove that the inventions are independent or distinct and that there is a serious burden on the examiner.

It is respectfully submitted that there would not be a serious burden upon the examiner in searching the invention group I and II.

First, the Examiner has failed to show any kind of serious burden. The Examiner mentioned that group I is classified in class 313, subclass 586 and group I is classified in class 445, subclass 24. The different classifications do not in themselves prove that there is a serious burden on the Examiner. As stipulated in *MPEP* §803, if the search can be made without serious burden, the

Examiner must examine it on the merits even if there are separate and distinct inventions. The Examiner has not alleged any serious burden in Paper No. 6 dated 16 April 2003 and thus the Examiner must examine the entire application.

Therefore, the applicant respectfully submits that the restriction requirement should be removed.

X I. SPECIFICATION

To assist the Examiner and to expedite compact prosecution of this application some corrections to the specifications were made.

The Examiner objects to the title as being not descriptive. Therefore, the title has been amended according to the Examiner's suggestion.

X II. DRAWING

The Examiner stated that the relative heights of the second and third dielectric layers as recited in claim 4 and the plurality of main and electrode lattice walls recited in claims 19 must shown in the claims.

Concerning the third and second dielectric layers of claim 4, the Examiner is directed to figure 31. The relative heights of the second dielectric 39 and the third dielectric 39' are clearly shown in the figure.

Concerning the main and electrode lattice walls, the main lattice wall is shown by references 15 (paragraph 84) and 35 (paragraph 168) for example and the electrode lattice wall is shown for example by references 17 (paragraph 64) and 37 (paragraph 149) in the drawings (for example figures 1, 2, 5, 6, 8, 24, 25, *etc.*

Paragraphs 60 and 146 were amended to show that the main barrier ribs are also called main lattice walls and electrode barrier ribs are also called electrode lattice walls.

Therefore, no update of the drawings are necessary.

III. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 1 through 11 and 19 through 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Komaki et al. (U.S. Patent 6,236,160) in view of Kaake et al. (U.S. Patent 6,307,318).

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references

when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

X The Examiner stated that Komaki does not teach or suggest of a second dielectric layer being formed on a distal end of each of the electrode barrier ribs/electrode lattice walls but that Kakke teaches in figure 14, col. 2, lines 47-50 and col. 3, lines 60-61 that a second electrode 92 and a second dielectric layer 94 may be formed on a distal end of the barrier ribs. However looking at figure 14 it can be seen that each and every barrier rib has the same configuraton, therefore there is a teaching away of the distinct main barrier ribs and electrode barrier ribs formed in between the main barrier ribs. According to MPEP §2145, "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). This portion of Kakke cannot be just ignored because according to MPEP §2141.02, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)." A reference may be said to teach away when a person of ordinary skill, upon reading a reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir.

electrodes?
ribs?

1994). Kakke is teaching that they would all be the same and therefore should not be combined with Komaki. (The present invention on the other hand has distinct main barrier ribs and distinct electrode barrier ribs.)

dependent claim

Further, for example in claim 3, the third dielectric layer is formed on the distal end of the main barrier ribs as opposed to the second electrode and second dielectric layer being formed on a distal end of each of the electrode barrier ribs. If Komaki were combined with Kakke, then there would be only a single type of barrier rib. Therefore, again Kaake is teaching away from the present invention.

X The first point in MPEP 706.02(j) states that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). The showing must be "clear and particular" without broad generalized conclusory statements. *Id.* There must be specific statements showing the scope of the suggestion, teaching, or motivation to combine the prior art references. *Id.* at 1000. There must be an explanation to what specific understanding or technical principle would have suggested the combination of references. *Id.* The Examiner stated that Kaake can be combined with Komaki because Kaake teaches that the configuration provides an improved back glass substrate for a plasma

display panel. An "improved" back glass substrate is respectfully broad and generalized and therefore an improper motivation.

OK X The Examiner stated that Kaake teaches in figure 14 that the second dielectric layer is formed on the second electrode which is formed the distal end of each of the barrier ribs. The Examiner further states that in figures 13-14 that a dielectric layer may be formed on every barrier rib using a method that will establish a height of an upper surface of the second dielectric layer and a third dielectric layer to be substantially the same, which is required to prevent the formation of gaps between discharge cells of different phosphors, thereby preventing erroneous emitted light.

However, a thorough search of the entire reference Kaake shows no such teaching. There is no mention that "a dielectric layer may be formed on every barrier rib using a method that will establish a height of an upper surface of the second dielectric layer and a third dielectric layer to be substantially the same, which is required to prevent the formation of gaps between discharge cells of different phosphors, thereby preventing erroneous emitted light" as mentioned by the Examiner. As mentioned above in MPEP §706.02(j), "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." Here the statements and reasonings are not found in the reference Kakke. Even if the Examiner is relying soley on figures 13 and 14, it still it does not clearly teach or suggest this as the drawings do not express the heights being necessarily substantially same and therefore no teaching. The reliance on a drawing for a rejection must be taken with caution, especially teachings of relative heights that

reduce manufacture time & money

are not expressed as being substantially the same in the specification or clearly marked in the drawings.

X If, however, the Examiner states that Kakke teaches of the heights of the upper surface of the third and second dielectric layers and a height of the upper surface of the second dielectric layers being substantially the same, then Kakke would be teaching away from claim 4 which mentions the height of the upper surface of the third dielectric layer being greater than a height of an upper surface of the second dielectric layer. As mentioned above, according to MPEP §2141.02, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)."

ok. use different
reference

The Examiner admits that Komaki and Kaaki are silent as to the height of an upper surface of the third dielectric layer being greater than a height of an upper surface of the second dielectric layer. Then the Examiner states that Komaki teaches in figure 7 that the discharge cells of the same phosphor share a common electrode, which is known to reduce the overall driving voltage and therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to construct the plasma display panel of Komaki including the electrode and dielectric layer structure of Kaake, and further include the height of the third dielectric layer being greater than a height of the upper surface of the second dielectric layer since this configuration would also allow the discharge cell of the same phosphor to share a common electrode.

This analysis is clearly improper. The Examiner admits that both Komaki and Kaake are

silent and therefore do not teach or suggest the limitation. The Applicant respectfully mentions to Examiner again that under MPEP §706.02(j) that “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner is using his own knowledge and the present invention to modify the references which are clearly forbidden. The policy reason for this is to avoid hindsight reconstruction that is improper. Quite clearly the references Komaki and Kaake make no such teaching or suggestion and therefore the presently claimed invention is not obvious.

7820 ~~✱~~ Concerning claim 10, the partitioned discharge cells include concave surfaces and a width of the partitioned discharge cell are formed to correspond to a color displayed by the particular partitioned cell. First, Kaake teaches away from a concave surface as in figures 14 and 15 a flat surface and not curved surface is shown. Further, the Examiner makes no mention of the partitioned discharge cell being of a certain width to correspond to the color displayed.

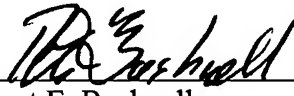
~~✱~~ Concerning claim 11, the Examiner states that Komaki and Kaake are silent as to the widths of the discharge cells but that is known in the art. Respectfully, again, the Examiner is relying on his personal knowledge. According to MPEP §2144.03 relating to “Reliance on Common Knowledge in the Art or ‘Well Known’ Prior Art” such reliance is not judiciously applied. Only in certain circumstances this can be done. The Examiner, has heavily relied on this throughout the rejection. The Examiner’s use of his knowledge does not meet the standards set in MPEP §2144.03 and therefore should not be used to such heavy extent. Furthermore, it is the right of the Applicant to demand authority be shown for all the reliance of what the Examiner calls as common knowledge.

Specifically here for example, one could even argue that Kaake may teach the widths to be all the same. Basically, it would be helpful to the Applicant and greatly appreciated that the Examiner base his rejection on the references and not on his personal knowledge because to do so with such frequency obviously means that the Examiner had not met his burden of proving a *prima facie* case.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,


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